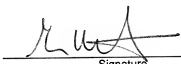


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) K2300.0001/P001	
		Application Number 10/025,773-Conf. #5870	Filed December 26, 2001
		First Named Inventor James H. Kerr, Sr.	
		Art Unit 2168	Examiner T. N. Pardo
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.</p> <p>Registration number <u>41,198</u> <u>62,381</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 50%; text-align: center;">  _____ Signature Gianni Minutoli Charles J. Monterio, Jr. _____ Typed or printed name _____ (202) 420-3191 Telephone number _____ January 27, 2009 Date </div> </div>			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
James H. Kerr, Sr.

Application No.: 10/025,773

Confirmation No.: 5870

Filed: December 26, 2001

Art Unit: 2168

For: ASSET ATTACHMENT DEVICE

Examiner: T. N. Pardo

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests a review of the legal and factual bases for the rejections in the above-identified patent application. Pursuant to the guidelines set forth in the Official Gazette Notice of July 12, 2005 for the Pre-Appeal Brief Conference Program, favorable reconsideration of the subject application is respectfully requested in view of the following.

The claimed system consists only of the elements recited in claim 1, where for example, using a device 12 located remotely from the physical asset 14, information is requested regarding the location of the physical asset 14 via communication means (e.g., a central server) 16. In use, a data signal (first data signal) is sent from the physical asset 14 to the communication means 16 corresponding to the location of the physical asset 14. Once the data signal is received, the communication means 16 sends the location of the physical asset 14 by transmitting a second data signal comprising the location of the physical asset to remote device 12, via the world wide web, where the location is stored, and, if desired, displayed. Physical asset 14 and remote device 12 are different devices. If the physical asset is not detected, remote device 12 will display a first color (e.g., red) status symbol. If the physical asset is detected in its

proper location, remote device 12 will display a second color (e.g., green) status symbol. If the physical asset is detected, but not detected in its proper location, remote device 12 will display a third different color (e.g., yellow) status symbol. See FIG. 1 of the present application and Applicant's illustration on the next page.

A. Withdrawal Of The Rejections Of Claims 1, 3, 5, 7-12 and 14-22 Is Warranted

According to the Final Rejection, dated November 17, 2008, claims 1, 3, 5, 7-12 and 14-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pike (U.S. Patent No. 6,459,371) in view of Bolavage (U.S. Publication No. 2002/0084889), in further view of Branscomb (U.S. Patent No. 7,240,364).

Claim 1 recites a tracking device system "consisting" of "a physical asset; a transmitter, attached to the physical asset, for transmitting a first data signal; a communication means for receiving the first data signal and subsequently transmitting a second data signal via a world wide web connection, the second data signal comprising a location of the transmitter; and a receiving means for receiving the second data signal and for housing a software program for enabling a user to use the received location to track the physical asset, wherein the physical asset, the communication means and the receiving means are different devices, in continuous communication and track the location of the physical asset, and the receiving means displays a status symbol corresponding to the location of the physical asset whereby if the status symbol is a first color the physical asset is not detected, if the status symbol is a second color the physical asset is detected but not detected in its proper location, and if the status symbol is a third color the physical asset is detected in its proper location."

Claim 3 recites a method of tracking an asset comprising the steps of "forming a communications network by forming a world wide web connection between a personal computer and central server; transmitting a first data signal in real-time, via the communications network, from the personal computer to the central server to inquire the location of a physical asset; communicating with the physical asset from the central server via the communications network; tracking the physical asset by transmitting a second data signal over the communications network, said second data signal comprising a location of the physical asset; interrogating the second data signal to determine a status signal; storing the determined status signal in the central

server; and outputting a status symbol representing the stored status signal, wherein the outputting step comprises outputting a first color status symbol if the physical asset is not detected, the outputting step comprises outputting a second color status symbol if the physical asset is detected in its proper location, and the outputting step comprises outputting a third color status symbol if the physical asset is detected, but not detected in its proper location.” Claims 20 and 21 recite similar features.

Claims 19 recites a computer system comprising “at least one website linked to the at least one server through the computer network, wherein the website provides a user interface through which a user can access a tracking program; and a tracking module.” Claim 19 further recites that the tracking module comprises a tracking device system “consisting” of: “a physical asset; a transmitter, attached to the physical asset, for transmitting a first data signal; a communication means for receiving the first data signal and subsequently transmitting a second data signal via a world wide web connection, the second data signal comprising a location of the transmitter; and a receiving means for receiving the second data signal and for housing a software program for enabling a user to use the received location to track the physical asset, wherein the physical asset, the communication means and the receiving means are different devices, in continuous communication and track the location of the physical asset, and the receiving means displays a status symbol corresponding to the location of the physical asset where if the status symbol is red the physical asset is not detected, if the status symbol is yellow the physical asset is detected but not detected in its proper location, and if the status symbol is green the physical asset is detected in its proper location.”

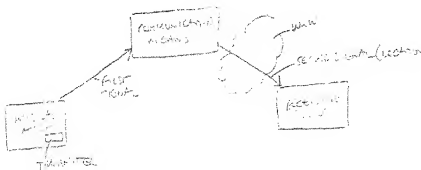
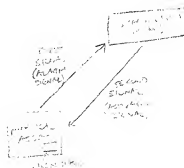


Illustration of an embodiment of the claimed invention



Pike

For at least the reasons set forth below, these limitations are not disclosed or suggested by the cited combination (Pike, Bolavage, and Branscomb). Referring to Applicant's illustration of Pike on the previous page, Pike discloses a two-way radio communication system for tracking a device's location. In Pike's system, there is 1) no receiving means, 2) no second signal carrying a location, and 3) no second signal being received by a receiving means which is a different device than the transmitter. Further, Pike does not disclose or suggest the "status" display system of the claimed invention; in other words, displaying 1) a first color (e.g., red) status symbol if the physical asset is not detected, 2) a second color (e.g., green) status symbol if the physical asset is detected in its proper location, and/or 3) a third color (e.g., yellow) status symbol if the physical asset is detected, but not detected in its proper location. Thus, Pike has four deficiencies in regards to the claimed invention: there is 1) no receiving means, 2) no second signal carrying a location, 3) no second signal being received by a receiving means which is a different device than the transmitter; and 4) no "status" display system.

The Final Rejection attempts to cure these four deficiencies of Pike by combining it with Bolavage and Branscomb. Bolavage, however, generally refers to an unrelated method and apparatus for communicating with RF tags using multiple frequencies. Bolavage refers to a method that can communicate with tags from various manufacturers. Bolavage is not designed to, or even relevant to, a system designed to track the location of physical assets. Hence, it is unreasonable to believe that one of ordinary skill in the art at the time of invention would have looked to a system that can communicate with tags from various manufacturers to modify a two-way radio communication system to achieve a tracking device system consisting of "[a] physical asset, . . . [a] communication means, . . . and [a] receiving means" where "the physical asset, the communication means and the receiving means are different devices, in continuous communication and track the location of the physical asset, and the receiving means displays a status symbol corresponding to the location of the physical asset whereby if the status symbol is a first color the physical asset is not detected, if the status symbol is a second color the physical asset is detected but not detected in its proper location, and if the status symbol is a third color the physical asset is detected in its proper location," for example, as recited in claim 1.

The Supreme Court said in *KSR Int'l Co. v. Teleflex Inc.* that "the [Graham] factors continue to define the inquiry that controls" a finding of obviousness and reiterated that a "patent

composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art” (127 S. Ct. 1727, 1734 (2007)), which is exactly the case here. The Office Action is using impermissible hindsight by using the claims of the present invention as a road map to improperly combine the references. *See Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. App. 1985); M.P.E.P. §2144.

Even if one of ordinary skill were to look to Bolavage, Bolavage fails to cure the four deficiencies of Pike. Bolavage does not teach or suggest a second signal carrying a location, a second signal being received by a receiving means which is a different device than the transmitter; and the “status” display system of the claimed invention. Branscomb equally does not teach or suggest the missing limitations. For example, even if it is assumed that Branscomb taught or suggested the “display” system of the claimed invention as suggested by the Final Rejection – which Applicant does not concede – several deficiencies still remain. Thus, whether considered alone or in combination, the cited references are defective, fail to teach or suggest all limitations of the claimed invention, and fail to provide a motivation to combine the cited references to achieve the claimed invention.

Therefore, Applicant respectfully submits that the cited combination of Pike Bolavage, and Branscomb fails to render obvious claims 1, 3 and 19-21; thus, the claims are allowable. Claim 5 depends from claim 3 and is allowable along with claim 3. Claims 10-12, 17 and 18 depend from claim 1 and are allowable along with claim 1. Claim 22 depends from claim 21 and is allowable along with claim 21. Accordingly, the pending § 103(a) rejection should be withdrawn.

B. Conclusion

In conclusion, Applicant respectfully submits that when Applicant’s evidence and arguments are considered, the cited combination does not teach or suggest all limitations of the claimed invention. Applicant respectfully requests that the pending § 103(a) rejection be withdrawn and the claims allowed without the burden of preparing an Appeal Brief.